



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-P-2022-0002]

Extension of Period to Allow Submission of a PDF with a Patent Application Filed in DOCX Format

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is continuing to modernize and streamline its patent application systems to support robust and reliable patent rights, speed the issuance of patents, and reduce the costs and barriers of global patent protection. The submission of patent applications in DOCX format facilitates the USPTO's ongoing efforts. The USPTO recognizes that, during the transition, some applicants have been hesitant to file patent applications in DOCX format. On April 28, 2022, the USPTO announced that, for a temporary period, ending on December 31, 2022, it was providing patent applicants with the option to submit an applicant-generated PDF version of the application along with the DOCX file(s) when filing an application in Patent Center. Based on stakeholder requests, the USPTO is extending the temporary period during which patent applicants have the option to submit an applicant-generated PDF of the application along with the validated DOCX file(s) when filing an application in Patent Center through June 30, 2023. To encourage greater adoption of DOCX so that the USPTO can move forward with its other modernization and harmonization efforts, there is no change to the January 1, 2023, effective date of the non-DOCX filing surcharge fee.

DATES: *Duration:* The option to submit an applicant-generated PDF of a patent application along with the DOCX file(s) when filing an application in Patent Center, as discussed in this notice, will be available through June 30, 2023.

Fee applicability: The non-DOCX filing surcharge fee set forth in 37 CFR 1.16(u) will go into effect on January 1, 2023.

FOR FURTHER INFORMATION, CONTACT: Mark O. Polutta, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7709; or Eugenia A. Jones, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7727.

For technical questions about submitting documents in DOCX format, please contact the Patent Electronic Business Center (EBC) at 1-877-217-9197 (toll-free), 571-272-4100 (local), or ebc@uspto.gov. The EBC is open from 6 a.m. to midnight ET, Monday-Friday.

SUPPLEMENTARY INFORMATION: Filing in DOCX format eliminates the need for patent applicants to convert structured text to PDF format, improves patent application quality by providing content-based validations prior to submission, provides automated document indexing, allows for future reuse of content, and improves searching for patent applications. It is also necessary for planned, upcoming USPTO efforts to automate more of the patent application process, including through pre-examination of applications to put applications in better shape before they are examined by a patent examiner. It is also critical to reducing barriers and costs affiliated with global intellectual property (IP) protection by ensuring that the different IP systems can communicate, electronically, with one another.

The USPTO appreciates the feedback and support from its stakeholders, including those who have switched to filing patent applications in DOCX format. The feedback from stakeholders during this transition to a DOCX system has been extremely helpful to the USPTO in improving its systems. The USPTO is no longer seeing any errors being

reported as a result of filing patent applications in DOCX format when applicants follow the guidance provided by the USPTO.

The USPTO recognizes that, during the transition, some applicants have been hesitant to file patent applications in DOCX format for fear that certain technical information including formulas might not be accurately reflected in the DOCX version. Accordingly, in April 2022, the USPTO announced that, for a period of time ending December 31, 2022, it was providing patent applicants with the option to submit a back-up applicant-generated PDF version of the application along with the DOCX file(s) when filing an application in Patent Center. *See Filing Patent Applications in DOCX Format*, 87 FR 25226 (Apr. 28, 2022). The USPTO believed that the initial period would encourage applicants to file in DOCX while ensuring that if any discrepancies were discovered, the back-up version could be used to correct the discrepancies. As with the DOCX version of the application, the applicant-generated PDF version also becomes part of the official record.

The USPTO expresses its gratitude to those who have used DOCX during this period and have reported any discrepancies. That effort allowed the USPTO to engage in enhanced testing of its information technology systems, and improve its guidance, as more users filed in DOCX. Even though the USPTO is no longer receiving discrepancy reports from those who file in DOCX following the USPTO's guidance, based on stakeholder requests, the USPTO is extending the temporary period to submit applicant-generated PDFs through June 30, 2023.

The USPTO reminds applicants that the option to submit an applicant-generated PDF version of the application is not available for applications filed via EFS-Web. The agency anticipates that more applicants will begin filing applications in DOCX format once the non-DOCX filing surcharge fee becomes effective on January 1, 2023. Nevertheless, extending the temporary period during which patent applicants have the

option to submit an applicant-generated PDF of the application along with the validated DOCX file(s) through June 30, 2023, will provide applicants additional time to gain confidence in the reliability and accuracy of the USPTO system when filing applications in DOCX format and safeguard the applicant should any conversion discrepancies take place. Applicants are also reminded that they can file test submissions through Patent Center training mode to practice filing in DOCX. Information on filing application documents in DOCX and a link to the DOCX training sessions are available at www.uspto.gov/patents/docx.

As discussed in the notice published on April 28, 2022, patent applicants who choose to submit an applicant-generated PDF with the validated DOCX file(s) when filing an application in Patent Center during the temporary period will not have to pay additional fees, such as an application size fee, as a result of filing the applicant-generated PDF, and, on petition, will be able to rely on the applicant-generated PDF if a discrepancy occurs during the filing process. To avoid incurring additional fees for the PDF, applicants must follow the process for submitting an applicant-generated PDF (Auxiliary PDF) set forth in the quick reference guide available at www.uspto.gov/sites/default/files/documents/Aux_PDF_QRG_Final_2022.docx. The USPTO will continue to waive the petition fee under 37 CFR 1.17(f) for a petition under 37 CFR 1.182 that relies on an applicant-generated PDF that was filed in Patent Center during the temporary period as the source to make a correction to the record. The USPTO will include the applicant-generated PDF in any certified copy of the application as filed, if the applicant-generated PDF remains part of the official record when applicant's request is processed. After the expiration of the temporary period (June 30, 2023), patent applicants who submit an applicant-generated PDF with the validated DOCX file(s) will need to pay the non-DOCX filing surcharge fee and any other additional fees, such as an application size fee, as a result of filing the applicant-generated PDF.

As a reminder, the USPTO published a final rule in the Federal Register that included a new non-DOCX filing surcharge fee, set forth in 37 CFR 1.16(u), with an effective date of January 1, 2022. *See* Setting and Adjusting Patent Fees During Fiscal Year 2020, 85 FR 46932 (Aug. 3, 2020). The USPTO later announced it was delaying the effective date of this fee until January 1, 2023. *See* Setting and Adjusting Patent Fees During Fiscal Year 2020, 86 FR 66192 (Nov. 22, 2021). The effective date of the non-DOCX filing surcharge fee now set forth in 37 CFR 1.16(u) is not being delayed. The non-DOCX filing surcharge fee, which applies only to non-reissue (original), nonprovisional utility applications filed under 35 U.S.C. 111, including continuing applications, will become effective on January 1, 2023. Small and micro-entity discounts will apply.

For more information regarding the filing of an applicant-generated PDF in Patent Center, including the options available for making corrections to the record, please see Filing Patent Applications in DOCX Format, 87 FR 25226 (Apr. 28, 2022).

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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